

REMARKS

Claims 1, 11, 13, 19, 23, 27-28, and 50 are amended, no claims are canceled, and claims 57-61 are added; as a result, claims 1-61 are now pending in this application.

Claim 50 was amended to overcome an obvious typographical error, specifically to add a period at the end of the claim. Claim 50 was not amended to overcome a prior art rejection, and no new matter was introduced through the amendment to claim 50.

Support for new claims 57-61 can be found in the specification, for example, on page 6 at lines 4-6. No new matter has been added through the addition of claims 57-61.

§102 Rejection of the Claims

Claims 1, 3, 5, 8, 10, 14, 15, 18, 20-24, 27, 31, 33, 37, 38, 43, 46, 47, 52, 55, and 56 were rejected under 35 U.S.C. § 102(b) as being anticipated by Collins et al. (U.S. 6,018,125).

Claims 1 as amended recites, "an absorber layer including an epoxy resin with particles having a high magnetic loss tangent covering at least a portion of each contiguous inner surface." Claim 13 as amended recites, "an absorber layer including an epoxy resin with particles having a high magnetic loss tangent covering at least a portion of each contiguous inner surface." Claim 19 as amended recites, "an absorber layer including an epoxy resin with particles having a high magnetic loss tangent covering at least a portion of each contiguous inner surface." Claim 23 as amended recites, "an absorber layer including an epoxy resin with particles having a high magnetic loss tangent." Claim 27 as amended recites, "an absorbing waveguide means including an epoxy layer covering at least a portion of the substrate." Claims 46 as amended recites, "the vent includes an EMI-absorbent material including an epoxy resin with particles having a high magnetic loss tangent." (Emphasis added in all instances). In each of claims 1, 13, 19, 23, 27, and 46, the recited layer, waveguide means, or material absorbs electromagnetic radiation.

In contrast, Collins et al. at column 2, lines 60-61 states, "A conductive layer is coated on at least a surface of the non-conductive plate interior to the enclosure and on the walls of the tunnel openings." (emphasis added) The conductive layer of Collins et al. is described at column 2, line 66 through column 3, line 2 which states, "A copper layer is plated on at least a surface of the non-conductive plate interior to the enclosure and on the walls of the tunnel openings. A

nickel layer is plated on the copper layer." Hence, there is no teaching in Collins et al. of "an absorber layer" or an "absorbing waveguide means" or "EMI-absorbent material" including a epoxy resin with particles having a high magnetic loss tangent or an epoxy layer capable of absorbing electromagnetic radiation, as recited in the claims 1, 13, 19, 23, 27, and 46 as quoted above. Thus, Collins et al. fails to disclose each and every element of the claims 1, 13, 19, 23, 27, and 46. Therefore, the 35 U.S.C. § 102(b) rejection of claims 1, 23, 27, and 46 cannot stand.

Claims 3, 5, 8, and 10 depend from claim 1; claims 14-15, 18, and 20 depend from claim 13; claims 21-22 depend from claim 19; claim 24 depends from claim 23; claims 31, 33, 37-38, and 43 depend from claim 27; claims 47, 52, and 55-56 depend from claim 46. Therefore, claims 3, 5, 8, 10, 14-15, 18, 20-22, 24, 31, 33, 37-38, 43, 47, 52, and 55-56 include all the elements of the claim from which they depend. For reasons analogous to those stated above with regards to claims 1, 13, 19, 23, 27, and 46 and elements in the claims, the 35 U.S.C. § 102(b) rejection of claims 3, 5, 8, 10, 14-15, 18, 20-22, 24, 31, 33, 37-38, 43, 47, 52, and 55-56 cannot stand.

For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claims 1, 3, 5, 8, 10, 14, 15, 18, 20-24, 27, 31, 33, 37-38, 43, 46, 47, 52, and 55-56.

§103 Rejection of the Claims

35 U.S.C. § 103(a) Rejection of claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50.

Claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins et al.

Applicant believes they have established that Collins et al. fails to teach or suggest all of the elements recited independent claims 1, 13, 19, 27, and 46. Claims 9, 12, and 45 depend from claim 1, claim 16 depends from claim 13, claims 34, 39-42, and 44 depend from claim 27, and claims 48-50 depend from claim 46. Therefore, claims 9, 12-13, 16, 34, 39-42, 44-45, and 48-50 include all of the elements recited in the claim from which they depend. Thus, Collins et al. fails to teach or suggest all of the elements included in claims 9, 12-13, 16, 34, 39-42, 44-45, and 48-50. Because Collins et al. fails to teach or suggest all of the elements included in claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, 48-50, the 35 U.S.C. § 103(a) rejection of these claims cannot stand.

In addition, with regards to claims 9, 12-13, 16, 19, 39-42, 44, 45, 48-50, the Office Action on page 3 states,

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to a specific material for manufacturing a product, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of engineering choice.

Also with regards to claim 34, the Office Action on page 3 states,

It would have been obvious to one of ordinary skill in the art at the time of the invention was made use a specific dimension, since such a modification would have been involved a mere change in size of a component. A change in size is generally recognized as being within the level of the ordinary skill in the art.

Applicant disagrees with these statements. Here, the Office Action admits that Collins et al. fails to disclose various elements recited in the claims, but proposes that these recited elements are obvious, and cites no other reference that teaches or suggests these missing elements.

The Office Action on page 7, in response to previous arguments objecting to the taking of official notice in a single reference 103(a) rejection states, "This is not persuasive and the office has provided a reference." Applicant disagrees. M.P.E.P. § 2144.03 states,

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21.

Further, M.P.E.P. § 2144.03 states,

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience— or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

The citing of the Collins et al. reference fails to meet the requirements dictated by M.P.E.P. § 2144.03. Therefore, Applicant respectfully objects to the taking of official notice in a single reference obviousness rejection; and pursuant to M.P.E.P. § 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing elements. If the Examiner cannot cite a reference that teaches the missing elements, Applicant respectfully requests that the Examiner provide an affidavit describing how the missing elements are present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50.

For at least the reasons stated above the 35 U.S.C. § 103(a) rejections of claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50 cannot stand. Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50.

35 U.S.C. § 103(a) Rejections of claims 2, 4, 6, 11-12, 15, 17, 25-26, 29-30, 32, 35, 51, and 53.

Claims 2, 4, 15, 35, 12, and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins et al. in view of Mitchell (U.S. 6,426,459).

Claims 6, 17, 25, 32, and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins et al. as modified by Mitchell in view of Clement et al. (U.S. 6,809,254).

Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins et al. in view of Pierce (U.S. 5,431,974).

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins et al. in view of Narang et al. (U.S. 5,976,666).

Claims 2, 4, 6-7, and 11-12 depend from claim 1. Claims 15 and 17 depend from claim 13. Claims 25-26 depend from claim 23. Claims 29-30, 32, and 35 depend from claim 27. Claims 51 and 53 depend from claim 46. Therefore, claims 2, 4, 6-7, 11-12, 15, 17, 25-26, 29-30, 32, 35, 51, and 53 include all of the elements recited in the claim from which they depend. Applicant believes they have established that Collins et al. fails to teach or recite all of the elements included in claims 1, 13, 23, 27, and 46. Further, the Office Action on page 5 admits

that Collins et al. fails to disclose an epoxy resin filled with particles having a high magnetic loss over the select frequency range. Applicant agrees. In addition, Applicant's representatives fail to find in Mitchell, Clement et al., Pierce, or Narang et al., a teaching or suggestion of an absorber layer including an epoxy resin or epoxy layer as recited in claims 1, 13, 23, 27, and 46. Thus, each of the proposed combinations of Collins et al. with Mitchell, Collins et al. with Mitchell and Clement et al., Collins et al. with Pierce, and Collins et al. with Narang et al. fails to teach or suggest all of the elements recited in claims 1, 13, 23, 27, and 46.

The Office Action on page 5 states, "Narang et al. disclose [sic] an absorber layer for an EMI shield including an epoxy resin filled with particles having a high magnetic loss over the selected frequency range [abstract]." Applicant disagrees. Narang et al. in the Abstract states, "The device is comprised of a perforated electrical absorbing layer, containing conductive polymers, laminated to a metal plate." Thus, Narang et al. fails to teach or suggest an absorber layer including an epoxy resin with particles having a high magnetic loss tangent, or an epoxy layer, as recited in claims 1, 13, 23, 27, and 46.

For at least the reasons stated above, the 35 U.S.C. § 103(a) rejections of claims 2, 4, 6, 11-12, 15, 17, 25-26, 29-30, 32, 35, 51, and 53 cannot stand. Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 2, 4, 6, 11-12, 15, 17, 25-26, 29-30, 32, 35, 51, and 53.

Reservation of Rights

Applicant does not admit that references cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such references should not be construed as admissions that the references are prior art.

AMENDMENT UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/027,345

Filing Date: December 20, 2001

Title: WAVEGUIDE WITH EMI ABSORBING COATINGS

Assignee: Intel Corporation

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Dkt: 884.690US1 (INTEL)

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9592 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26th day of September, 2005.

Amy Moriarty
Name

[Signature]
Signature